

October Term, 1935

No. 361

LINCOLN STORE, INC.,
Petitioner,

NASHUA MANUFACTURING COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR CERTIORARI

✓ J. L. STACKPOLE,
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In the
Supreme Court of the United States.

OCTOBER TERM, 1946.

No. 768.

LINCOLN STORES, INC.,
PETITIONER,
v.
NASHUA MANUFACTURING COMPANY,
RESPONDENT.

**BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR CERTIORARI.**

INTRODUCTORY STATEMENT.

This is an ordinary patent suit on a patent of narrow and definite scope. It involves no conflict of decisions between different Courts of Appeal, but only concurrent findings by the two lower Courts. It raises no new or doubtful question of law and no matter of public importance.

As in *Goodyear Co. v. Ray-O-Vac Co.*, 321 U.S. 275, and *Williams Co. v. United Shoe Machinery Corp.*, 316 U.S. 364, the petition seeks, in effect, a review by this Court of concurrent findings of fact by the District Court (Wyzanski, J.) and of the Court of Appeals (Mahoney, J. and Magruder, J., with Woodbury, J. dissenting) which fully support the findings of validity and infringement by both Courts. In the petition there is no denial of infringement, novelty and utility.

The chief issue presented is that of patentable invention,

the test of which, as stated by this Court in *Sinclair Co. v. Interchemical Corp.*, 325 U.S. 327, 330, is whether the subject-matter displays "more ingenuity . . . than the work of a mechanic skilled in the art". **Both the District Court and the Court of Appeals found this test fulfilled by Amory's invention.**

The history of the art, its struggles and failures and Amory's success, set forth in concurrent findings of both Courts, constitute to a most unusual degree those factors which this Court in *Goodyear v. Ray-O-Vac*, *supra*, held sufficient to determine invention, and amply fulfill all the tests of patentable invention which this Court cited with approval in that case.

Both lower Courts concurred in finding invention both as a matter of law and as a matter of fact. There is no suggestion by the Court of Appeals that it is requesting this Court to decide whether invention is a question of law or one of fact. Nor was the Court of Appeals guided in its decision by a "procedural rule" rather than by the merits of the case in both law and fact.

Findings of fact by both Courts establish that the Amory blanket differed from the prior art not merely in degree but in kind.

Both lower Courts have likewise made concurrent findings of fact that the alleged indefiniteness of the claims, which petitioner asserts as a further basis for review, does not exist.

Petitioner's assertions as to public interest and alleged dominance of this very specific patent over blanket manufacture and the health and welfare of the public are most extravagant and wholly untrue. No matter of public importance is involved.

THE SIGNIFICANT FACTUAL BACKGROUND OF THE INVENTION.

Petitioner's statement of facts does not accurately reflect the findings of the Courts below as to the nature and factual background of Amory's invention.

The blanket of the patent in suit is a relatively inexpensive blanket which is of greater warmth than any other sort of blanket, including wool blankets, in the same and even somewhat higher price range. Not only that, but it lasts and washes as well as such wool blankets.

Wool blankets had long been the standard of excellence for the reason that the wool fibers make up into a high, lofty, homogeneous nap on each side of the blanket, which nap is full of myriads of small air spaces affording the best possible heat insulation, *i.e.*, they prevent the transfer of heat through the blanket.

For years prior to Amory's invention, skilled workers in the art had been endeavoring to make a blanket essentially of rayon fiber which would have a warmth and lasting qualities comparable to a wool blanket but would be less expensive because of the relatively low cost of rayon. But their efforts had been failures. The rayon blankets they produced lacked the characteristic lofty, uniform, homogeneous nap of wool blankets, which gives them their warmth, and the naps of their blankets shed excessively.

The difficulty of producing a blanket with a nap, substantially of rayon, having these characteristics of a nap of wool, had proved insurmountable to all others before Amory because of the radical antithetic difference between wool and rayon. Wool is curly, springy and covered with rough overlapping scales. These characteristics cause the wool fibers, when napped as in blanket making, to intertangle and support each other to form a lofty homogeneous substantially non-shedding nap containing the myriads of air spaces which inhibit the transfer of heat. Rayon is the

opposite. It is smooth, straight and stiff, like a fine glass thread.

These radical differences, coupled with the failure of all attempts to produce a rayon blanket comparable to a wool blanket, had led skilled workers in the art to believe that such a result was impossible.

The Court of Appeals found:

“Blankets made essentially of rayon had been known for many years but until the Purrey blanket was placed on the market no rayon blanket achieved any great degree of commercial success. This was due to the fact that the nap of the rayon blankets prior to Amory was not lofty or uniform and shed easily. Men skilled in the art attributed this to the unelastic, straight, smooth qualities of rayon, and thus they believed that rayon could not be used to produce a blanket similar in quality to a wool blanket. Wool, however, is elastic, curly and rough.” Tr. p. 408.

“The attainment of the result reached by Amory required more than merely substituting rayon fibers for the wool fibers used by Neaves. The qualities of the two materials are vastly different. What would have resulted from a mere haphazard substitution is highly speculative. For years, men skilled in the art had endeavored to substitute rayon for wool in the manufacture of blankets with little success. That made it amply clear that such a substitution would not achieve the desired result without knowledge of the particular type of rayon fiber needed. Amory was the first to disclose that the fibers must be of relatively coarse denier and that they should be cut to a specific predetermined length. Without the disclosures made by Amory, we cannot say that a substitution would have been successful.” Tr. p. 411.

"Amory's patent was the first to teach that a blanket constituted chiefly of rayon fibers would be successful only if the fibers were of a specified length and denier, undrafted and loosely wound around the hard-twisted core." Tr. p. 412.

"Amory's combination produced a new result, although it may have been composed solely of known ingredients, and there is evidence that this result was not expected by the art. Amory's blanket was eagerly received by the consuming public. The Amory patent meets all the tests set forth by the cited cases." Tr. p. 417.

These essential holdings of the Court of Appeals confirm the findings of the District Court. Tr. pp. 31, 32, 35-39.

Among the many attempts and failures which preceded Amory's invention were those of the expert blanket makers of Marshall Field & Co., the real defendant and petitioner in the case. These began in 1927.

The Court of Appeals found that:—

"As late as 1938 Marshall Field did not know Amory's secret." Tr. p. 414.

Finally in 1940, after thirteen years of effort and failure, Marshall Field made its first successful rayon blanket by copying the Purrey blanket of the Amory patent.

Both courts below found that none of these prior unsuccessful blankets nor any of the numerous patents and publications relied on by petitioner discloses or even suggests the Amory invention (Tr. pp. 410-415; 35-38).

It is with this background of facts, found by the District Court and affirmed by the Court of Appeals—the long felt want, the apparently insurmountable difficulties of the problem, the struggles and failures of the prior art, the success first achieved by Amory, the immediate imitation

and wanton infringement by Marshall Field—that petitioner's five points are to be evaluated.

PETITIONER'S FIRST AND SECOND POINTS ARE FICTITIOUS.

Petitioner's first and second points are without substance. No one, either counsel or Court, has heretofore based an argument either for or against patentable invention in this case on whether or not the question of patentable invention was one of law or one of fact. It is a fictitious unsubstantial issue here because in either case such invention is present and it was so held both by the District Court and by the Court of Appeals.

This alleged procedural issue is mere pretext by which petitioner seeks to cloak its effort to obtain an unwarranted review of the concurring decisions on the merits. Petitioner does not ask that the Court of Appeals be directed to reconsider invention as a matter of law, the appropriate remedy if that Court had really considered itself "foreclosed" and "precluded" from applying the law by erroneously regarding the District Court finding of invention as one of fact (petition, pp. 5, 11, 13-14). Instead, petitioner, being well aware that the Court of Appeals found invention both in fact and in law, asks this Court to review and reverse that finding on the merits (petition, pp. 8, 21).

Fundamentally the test of invention is that stated by this Court in *Sinclair Co. v. Interchemical Corp.*, *supra*, p. 2.

The Court of Appeals repeatedly points out that the facts show invention by that test, according to established principles of law (Tr. pp. 412-417):—

"Without the disclosures made by Amory, we cannot say that a substitution [rayon for wool] would have been successful. Nor can we say that the substitution specified by Amory was apparent to a man skilled in the art. The many years of futile research and labor by men skilled in the art is weighty evidence of this.

Williams Iron Works Co. v. Hughes Tool Co., 109 F. (2d) 500, 510 (C.C.A. 10, 1940)."

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"Staple rayon had been known and was available, at least for research purposes, many years before Amory applied for his patent. And yet no one had thought to use it in the combination or process evolved by Amory. This is certainly evidence of invention. *Dewey & Almy Chemical Co. v. Mimex*, *supra*, at 987."

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"The fact that these elements were known for some time prior to Amory and that the successful combination remained undiscovered before Amory's patent is entitled to considerable weight. Rayon staple was known for many years before Amory, but the art had taught that the most beneficial use of these fibers would be derived by spinning them into a thread rather than leaving them undrafted and randomly intermingled. The previous adoption of an essential element of a patent for another and distinct purpose does not constitute anticipation. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 58 (1923)."

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"But, here, there is, at least doubt on the question of invention. In such a case, it is elementary that the existence of the problem for many years, without solution in spite of prolonged efforts by numerous experts, and the rapid public acceptance of the proffered solution, are entitled to consideration as weighty evidence of invention. *Hughes Tool Co. v. International Supply Co.*, 47 F. (2d) 490, 492 (C.C.A. 10, 1931)."

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"But the fact that a new combination of old elements produces a new and beneficial result, hitherto un-

attained, merits consideration as evidence of invention. *Loom Co. v. Higgins*, 105 U.S. 580, 591 (1881)."

"And a substitution which involves a new mode of construction, or develops new uses and properties of the article formed, may amount to invention. *Smith v. Goodyear Dental Vulcanite Co.*, *supra*, at 492, distinguishing *Hotchkiss v. Greenwood*, 11 How. 248."

"A patentable combination may be comprised of elements that are all old or all new, or partly old and partly new. *Leeds & Catlin Co. v. Victor Talking Machine Co.*, (No. 2) 213 U.S. 325, 332 (1909)."

"Where none of the patents in the prior art disclose all the elements of the patent in issue, they cannot be combined for that purpose, *Cover v. Chicago Eye Shield Co.*, 111 F. (2d) 854, 859 (C.C.A. 7th, 1940)."

"An inventor cannot be denied the rights derived from a patent merely because he has combined elements, all of which were known to the prior art, if he has produced something involving novelty and utility. *National Aluminate Corp. v. Permutit Co.*, 145 F. (2d) 175, 179 (C.C.A. 8, 1944); *Monarch Marking System Co. v. Dennison Mfg. Co.*, 92 F. (2d) 90, 94 (C.C.A. 6, 1937)."

"A finding of invention may be warranted where the patentee combines features, even though all of them are known to the prior art, which produce a new result, especially where that combination enjoys marked commercial success. *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279 (1944); *Halliburton Oil*

Well Cementing Co. v. Walker, 146 F. (2d) 817, 819 (C.C.A. 9, 1944); *Texas Rubber & Specialty Corp. v. D. & M. Machine Works*, 81 F. (2d) 206, 208 (C.C.A. 5, 1936)."

"That on retrospect the device appears simple or obvious does not necessarily establish a lack of invention. *Loom Co. v. Higgins*, *supra*, at 591."

"It is indeed significant in this respect that the workers in the art had labored long and extensively to produce the blanket first produced by Amory. *Potts v. Creager*, 155 U.S. 597, 608 (1895)."

"Retrospection is often deceptive and cannot be accorded recognition in the law pertaining to patents. *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 435 (1911)."

"At least Amory provided the final step that proved the difference between success and failure. This is a factor which has been accorded considerable recognition in the courts. *The Barbed Wire Patent*, 143 U.S. 275, 283 (1892); *Consolidated Safety-Valve Co. v. Crosby Steam Gauge & Valve Co.*, 113 U.S. 157, 179 (1885)."

The foregoing are established rules of law applicable to the judicial determination of the question of patentable invention.

The Court of Appeals found Amory's invention to be patentable as a matter of law saying, Tr. p. 417:—

"The Amory patent meets all the tests set forth by the cited cases."

The Court, in order to leave no doubt as to the thoroughness of its decision, also found that, if the question was viewed as one of fact, the same conclusion must be reached:

“The presumption of the validity of Amory’s patent arising from its issuance, *Mumm v. Decker & Sons*, 301 U.S.168, 171 (1937), taken together with the many years of effort to produce what Amory produced and its substantial commercial success, makes it impossible for us to say that the district court was clearly erroneous in deciding that Amory had produced a patentable invention. Rule 52a, F.R.C.P.” Tr. p. 418.

The Court of Appeals thus held, both as a matter of law and as a matter of fact, that Amory had made a patentable invention. The Court found it “impossible” to differ from the District Court finding of invention because Amory’s accomplishment satisfied all the legal tests of invention, not because of “the exacting requirement of Rule 52(a)” as the petition contends (p. 4).

The foregoing is a complete answer to the petitioner’s contention that the opinion of the Court of Appeals is virtually a request that this Court determine in this case whether the question of patentable invention is one of law or one of fact. That there is no such request, the opinion speaks for itself.

Moreover, petitioner’s argument is unsubstantial because the Court of Appeals had the right, if it so wished, to certify such a question to this Court. That it did not do so leaves no doubt but that a decision of such question was not material to its decision.

Petitioner’s assertion that the decision of the Court of Appeals was based on “procedural grounds” is wholly unfounded. The Court’s affirmance of the finding of invention as one of “fact” was but the confirmation of its hold-

ing that the patent satisfies all the tests of invention according to settled rules of law.

There is no statement or even a hint or suggestion that its decision turned on the point whether patentable invention is a question of law or of fact, and the opinion affirmatively shows the contrary, as above pointed out.

PETITIONER'S THIRD POINT IS UNSOUND.

Petitioner's third point, that the advance in the art made by Amory was one of degree, not of kind, and hence unpatentable, is unsound.

The advance in the art made by Amory was the production of a blanket made substantially of rayon which had a nap having the qualities of a wool nap.

Here was a new result, a change in kind not merely one of degree. Both the District Court and the Court of Appeals so found and held.

The Court of Appeals found:—

“But these publications do not teach the lesson which the art awaited. They only teach the existence of the materials utilized by Amory. They do not disclose, as did Amory, that when rayon fibers are used in a blanket construction they must be 1" – 2" in length and of a denier of at least 4.00 and kept in a randomly intermingled state, loosely wound around a core thread. Amory's precise combination was unknown to the art, although, perhaps, all of its elements had been previously disclosed and utilized. There is no indication from the prior publications or patents that the combination of elements used by Amory would produce a nap having the lofty, uniform and warmth-giving characteristics of the Purrey blanket.” Tr. p. 413.

“It was not until Amory used staple rayon of specified length and denier that the result toward which the

efforts of the art had been directed was obtained.” Tr. p. 414.

“Amory’s combination produced a new result, although it may have been composed of known ingredients, and there is evidence that this result was not expected by the art.” Tr. p. 417.

These holdings by the Court of Appeals confirm the findings of the District Court. Tr. pp. 35–40.

On such a matter of fact there was no conflict between the findings of the Courts. This Court has ruled that it will not disturb such concurrent findings of the lower Courts.

Goodyear Co. v. Ray-O-Vac Co., 321 U.S. 275.

Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U.S. 364, 367.

Judge Woodbury in his dissenting opinion stated that “the distinction [between differences in degree and differences in kind] is unsatisfactory in that each case must be decided on its own facts as it arises and in close cases like the present differences of opinion are normally to be expected”. He differed from both the District Court and the majority of the Court of Appeals only on this question of fact.

The majority specifically held that the decision in *Hotchkiss v. Greenwood*, 11 How. 248, relied on by the dissenting judge and by petitioner, was inapplicable and that the case was governed instead by *Smith v. Goodyear*, 93 U.S. 486, saying:

“A substitution which involves a new mode of construction, or develops new uses and properties of the article formed, may amount to invention. *Smith v. Goodyear Dental Vulcanite Co.*, *supra*, at 492, distinguishing *Hotchkiss v. Greenwood*, 11 How. 248 . . .

The Amory patent meets all the tests set forth by the cited cases." (Tr. pp. 416-417.)

There is no "rule of law" that a substitution of one material for another is not patentable invention.

To the contrary are such authorities as—

Smith v. Goodyear, 93 U.S. 486, 495.

Potts v. Creager, 155 U.S. 597, 608, 609.

In *Celluloid Mfg. Co. v. Frederick Crane Chemical Co.*, 36 Fed. Rep. 110, Justice Bradley, sitting with the Circuit Court of New Jersey, said, p. 112:—

"There is no rule of law that the substitution of one material for another is not patentable. In processes of manufacture, and in compositions of matter, such a substitution often effects material changes in the result, either as to the product or the expense."

In *Remington Rand v. Acme Co.*, 71 F. (2d) 628 (C.C.A. 4th) the Court said p. 632:—

"There is, however, no rule of law that the substitution of a new material for an old is not patentable. The question is always whether the alteration requires invention or merely the exercise of mechanical skill and judgment. The answer must be found in the light of the circumstances of the particular case."

PETITIONER'S FOURTH POINT IS UNSOUND.

There is nothing indefinite or vague about the claims sustained by the Court of Appeals. Both Courts concurred in finding that the alleged indefiniteness of the claims which petitioner asserts as its fourth point does not exist in fact.

The opinion of the Court of Appeals states:—

"The defendant challenges claim 7 of the Amory patent as not meeting the standards of clarity required by R. S. 4888 because it is impossible to determine

whether a given blanket infringes the patent. This challenge is based on the defendant's assertion that the word 'staple' as used in the claim has no exact meaning. The defendant asserts that the word 'staple' is used merely to distinguish short filaments from long filaments; that staple rayon is made by cutting long filaments into relatively short lengths or fibers, ordinarily of uniform length; that staple fibers are found in both the uniformly cut fibers and in garnetted material. The district court held, however, that the word 'staple' as commonly used in the rayon industry and as used in this patent, means a filament cut to a predetermined length and that this definition read in the light of the specifications requires that the filling wrapping contain fibers of a predetermined length, preferably 1" to 2", and it concluded that there was no difficulty in deciding which blankets infringe and which do not. We agree with the district court."

Such concurrent findings of the two lower Courts are accepted by this Court (*supra*, p. 12).

In Amory's claims there is no all-inclusive language at the point of novelty, which extends them beyond his limited invention, as in the recent case of *Halliburton Oil Well Cementing Co. v. Walker*. The decision of this Court in that case, on which petitioner relies, is not relevant.

PETITIONER'S FIFTH POINT IS UNSOUND.

The Court of Appeals, in sustaining the claims of the Amory patent, did not in the least ignore the public interest. Its decision did not involve a matter of public importance beyond the usual public interest in all patent cases which the Court carefully guarded by a most thoroughgoing review of the facts and pertinent authorities.

The Amory patent, as to the claims sustained, is a narrow patent on a blanket composed in a particular way of a specified kind of rayon staple.

As the invention has proved commercially successful Marshall Field would like to copy it, but this is no ground for asserting that a matter of public interest or importance is involved in this case.

Marshall Field and all other blanket manufacturers can make other sorts of blankets, cotton blankets, wool blankets and blankets made with rayon of different deniers and different lengths than those covered by the patent.

The patent is limited to the particular blanket structure which was new with Amory and takes nothing from the public.

CONCLUSION.

For the foregoing reasons the Petition is without merit and should be denied.

Respectfully submitted,

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